

AMENDMENT UNDER 37 C.F.R. § 1.111  
U. S. Application No. 09/834,942

**REMARKS**

Claims 1-9 are all the claims pending in the application.

As a preliminary matter, Applicant thanks the Examiner for acknowledging Applicant's claim for foreign priority and receipt of the certified copy of the priority documents. The Official Draftsperson has not yet reviewed the drawings. Applicant requests that the Official Draftsperson review the drawings and that a completed PTO-948 Form be included with the next Office Action.

The Examiner has stated that the IDS filed on July 16, 2001, fails to comply with 37 C.F.R. § 1.98(a)(3). Upon reviewing the references submitted along with the IDS, Applicant has confirmed that all the appropriate references listed on the IDS were correctly submitted, but that three extraneous Japanese Patent Publications (Jpn. Patent Publ'n Nos. 10-232824, 11-87922, and 11-242876) were submitted and listed on the IDS in error. As these three publications are not relevant to the present application, Applicant requests the Examiner to disregard these extraneous publications. The requisite English language descriptions of the remaining foreign language references were timely submitted in the Information Disclosure Statement of July 16, 2001.

Applicant thanks the Examiner for pointing out that the postal code of 258-8538 was not supplied for the mailing address identified under 37 C.F.R. § 1.63(c)(1). Applicant confirms that 258-8538 is the correct postal code.

Claims 1-6 are pending in the application. Claims 1, 2, 4, 5/4, 5/2, 3, 5/3, and 5/1 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fender et al. (U.S. Patent No. 5,300,784A) ("Fender") in view of Tonami et al. (JP 8-306328 A) ("Tonami"). Claims 6/4, 6/2,

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6/3, and 6/1 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fender and Tonami as applied to claims 4, 2, 3, and 1 above, and further in view of Letter (U.S. Patent No. 3,556,787A) ("Letter"). By this amendment, Applicant adds new claims 7-9 to more particularly claim the invention and the following arguments to traverse the prior art rejections.

Applicant's invention relates to a planar electrostatic recording material for recording image information and for generating electric currents when the electrostatic recording material is scanned to read the image. The invention includes a flat plate-shaped substrate permeable to a reading electromagnetic wave that supports the electrostatic recording material from a side of the read-out surface. A flat plate-shaped base plate supports the substrate from a side opposite to a surface of the substrate and has a rigidity higher than the rigidity of the substrate.

Fender relates to an electrophotographic imaging member having an optically transparent substrate. An x-ray image is formed from the side of the photoreceptor opposite the transparent substrate and then is scanned from the back side through the transparent substrate. Tonami relates a device with a glass plate 21 bonded to a glass thin plate 22 by an optical bonding agent layer 25. A transparent electrode 26 and an amorphous selenium film 23 are formed on the glass thin plate 22.

In the Office Action, Examiner has rejected claims 1, 2, 4, 5/4, 5/2, 3, 5/3, and 5/1 under § 103(a) as unpatentable over Fender in view of Tonami. Applicant believes that the Examiner is incorrect.

In combination with other features, claim 1 recites an imaging apparatus comprising a planar electrostatic recording material and " ii) a flat plate-shaped substrate, which supports the electrostatic recording material from the a side of the read-out surface, . . . and iii) a flat plate-

shaped base plate for supporting the flat plate-shaped substrate from a side opposite to a surface of the substrate, on which surface the electrostatic recording material is formed, the flat plate-shaped base plate having a rigidity higher than the rigidity of the substrate . . . .”

Although the Examiner concedes that Fender does not disclose a support for recording material 1 (amorphous selenium photoreceptor) or the substrate 11, the Examiner states that Tonami discloses the deficiencies of Fender. To the contrary, Tonami does not disclose a base plate for supporting a substrate from a side of opposite to a surface of the substrate on which the electrostatic recording material is formed. FIGS. 1 and 2 of Tonami shows an amorphous selenium film 23 without any base plate which would likely provide rigid support to a side of a substrate opposite to the amorphous selenium film 23. FIG. 2 shows that the glass plate 21 and glass thin plate 22 are both located on the recording side of the film 23 as recited in claim 1. By contrast, claim 1 discloses a plate shaped substrate on the read out side of the recording material, and a base plate supporting the substrate opposite the recording material. Accordingly, the plate is also on the read out side, which is the opposite disposition of the elements 21, 23 in Tonami.

The Examiner contends that the relative rigidity of the base plate and substrate is suggested by the thickness of the plate in Tonami. The rationale is not supported since the relative scale across multiple references certainly cannot be ascertained with any particularity. See MPEP 2125 (references, in general, are not drawn to scale). The Examiner is merely speculating as to this aspect of the references.

In addition, Applicant submits that Fender may not be properly combined with Tonami. Tonami discloses the glass plate 21 having a number of very fine holes filled with fluorescent material 24. If the glass plate 21 is used on the reading side of the substrate, as the Examiner

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suggests, then the fluorescent material 24 would interfere with an accurate reading of the image on the film. Therefore, there is nothing to indicate that it would have been obvious to modify the imaging apparatus of Fender with the glass plate 21 of Tonami to render claim 1 obvious.

Since the Examiner has not shown that the flat plate-shaped base plate as recited in claim 1 is obvious to one skilled in the art or that there is proper motivation or suggestion to modify the references to render the imaging apparatus recited in claim 1 obvious, the Examiner has failed to set forth a prima facie case of obviousness. Applicant submits that claim 1 is patentable and requests the Examiner to withdraw the rejection of claim 1.

Claims 2, 4, 5/4, 5/2, 3, 5/3, and 5/1, which depend from claim 1, are believed to be patentable for at least the reasons discussed above for claim 1. The recitations regarding thermal expansion and refractive indices are not taught or suggested in the art.

Claims 6/4, 6/2, 6/3, and 6/1 are rejected under § 103(a) as being unpatentable over Fender and Tonami as applied to claims 4, 2, 3, and 1 above, and further in view of Letter. Applicant maintains that the rejection is not supported for the reasons below.

The Examiner states that it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the imaging apparatus suggested by Fender and Tonami to further comprise the formation of an anti-reflection coating as disclosed by Letter.

Letter relates to a photoelectric element for recording information having three solid layers superimposed in contiguous relations including an electron conducting layer, an electron sensitive layer and a photoconductive layer. The photoelectric layer is exposed to radiation and to an electron beam to record the information. Letter discloses an anti-reflection film coating the bombarded film which is bombarded by electrons in the recording process.

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Contrary to the Examiner's assertions, the anti-reflection coating disclosed by Letter fails to render claim 6 obvious. First, Letter fails to disclose or suggest the use of an anti-reflection coating for a base plate which is scanned by a reading electromagnetic wave as recited in claim 6, but merely discloses the use of an anti-reflection coating on a film upon which information is recorded (col. 3, lines 55-57).

Second, Applicant submits that the Examiner has offered no explanation as to why one skilled in the art would be motivated to combine Fender and Tonami with Letter. Letter discloses an anti-reflection coating to improve the optical characteristics of the film which is exposed to light flux and electron bombardment (col. 3, lines 18-28 and 55-59). The combination of Fender and Tonami, however, discloses a photoreceptor exposed to a scanning light beam (Fender, col. 6, lines 35-38), not to light flux or electron bombardment. In other words, there is nothing in any of the references that suggests the use of an anti-reflection coating with a scanning light beam.

Therefore, it would not have been obvious to modify what is disclosed by Fender and Tonami with the anti-reflective coating disclosed by Letter. In effect, to combine Fender and Tonami with Letter is to engage in impermissible hindsight reconstruction because the Examiner has not put forward sufficient reasons to combine the references. Applicant submits that claims 6/1, 6/2, 6/3, and 6/1 are patentable and request the Examiner to withdraw the rejection of the claims.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

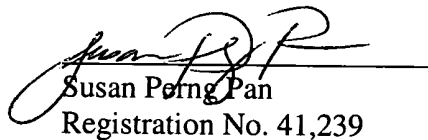
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Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

  
Susan Peing Pan  
Registration No. 41,239

WASHINGTON OFFICE



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